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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,275	10/28/2003	Bob G. Sanders	CLFR:178USD1	4689

7590 01/24/2007
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EXAMINER	
KHARE, DEVESH	
ART UNIT	PAPER NUMBER
1623	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/695,275

Applicant(s)

SANDERS ET AL.

Examiner

Devesh Khare

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,14-16,18-24,34-38,40-48,58-62 and 64-67 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,14-16,18-24,34-38,40-48,58-62 and 64-67 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/4/2007</u> . | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 1623

The Pre-Appeal brief request received on 11/01/2006 has been considered. A conference has been held. The rejections of the Office action dated 8/01/2006 have been withdrawn.

1. In view of the Pre-Appeal brief filed on 11/01/2006, PROSECUTION IS HEREBY REOPENED. During the course of reconsideration of the application, a prior art reference not previously disclosed by the applicants or the examiner came to light. See the rejection as set forth below.

Claims 1-6,8,14-16,18-24,34-38,40-48,58-62 and 64-67 are currently pending in this application.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6,8,14-16,18-24,34-38,40-48,58-62 and 64-67 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,645,998 ('998).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in each of the application and the '998 patent are directed to substantially the same subject matter, i.e., in the instant claims, the invention is claimed in terms of a method for inhibiting the growth of tumor cells in an individual, comprising administering to the patient a pharmacologically effective dose of a compound having a structural formula presented in claim 1 wherein X and Y=oxygen; R¹ is $-(CH_2)_{1-5} CO_2H$; R² and R³ are H; R⁴ is methyl ; and R⁵ is a C₇₋₁₆ olefinic group containing ethylenic bonds, while in the '998 patent it is claimed in terms of a method for the treatment of a cell proliferative disease in an animal comprising administering to an animal a pharmacologically effective dose of a compound having a structural formula presented in claim 1 wherein X and Y=oxygen; R¹ is $-C_{1-10}$ alkylene CO₂H; R² and R³ are H; R⁴ is C₁₋₄ alkyl ; and R⁵ is a C₇₋₁₇ olefinic group containing 3 to 5 ethylenic bonds. Furthermore, the compounds used in claims 2,3,16,18-24,34-38,40-48,58-62 and 64-67 are obvious over the prior art's compounds of Fig. 1 and claim 2. Those of skill in this art would have recognized that a pharmacologically effective dose of compound having a structural formula presented in claim 1 of the '998 patent can be used in a method for inhibiting the growth of tumor cells in an individual (also see claim 8 of the '998 patent). One of ordinary skill in the art would be motivated to use a pharmacologically effective dose of a compound having a structural formula presented in claim 1 since the beneficial effects of said compound or structurally close compound is individually taught in the prior art to be used in the same or similar method.

The examiner notes the instant claims and the '998 patent of applicants do indeed substantially overlap therefore this obviousness-type double patenting rejection is necessary to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. Therefore the claims are co-extensive.

Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to Devesh Khare whose telephone number is (571)272-0653. The examiner can normally be reached on Monday to Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anna Jiang, Supervisory Patent Examiner, Art Unit 1623 can be reached at (571)272-0627. The official fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Devesh Khare, Ph.D., J.D.
Art Unit 1623


Anna Jiang, Ph.D.
Supervisory Patent Examiner
Technology Center 1600

January 16, 2007